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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,797

11/26/2003

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4139

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EXAMINER

BERHANU, ETSUB D

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

11/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,797

Applicant(s)

ALARCON ET AL.

Examiner

Etsub D. Berhanu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6,7,12,19-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7,12,19-32 and 34-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/15/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1, 3, 6, 7, 12, 19-32, 34, 35, 37, 38 and 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcala et al.'405 (previously cited) further in view of Lakowicz et al.'534 (previously cited) further in view of Crowley'229 (USPN 6,289,229).

See rejection set forth in paragraph 2 of Office Action mailed out 20 October 2006.

Alcala et al.'405 further in view of Lakowicz et al.'534 discloses all the elements of the current invention, as discussed in paragraph 2 of the previous Office Action, except for the device comprising a needle or catheter tip that houses and protects the optical conduit and the sensing element within the tip. Crowley'229 teaches the use of a needle or catheter as a cover/tip of a sensing device in order to be able to easily introduce the sensing device within the body of a subject and also to locate the sensing device precisely within the test subject while causing minimal trauma to the surrounding tissue of the subject (col. 6, lines 36-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Alcala et al.'405 further in view of Lakowicz et al.'534 to include a catheter or needle tip that houses the optical conduit and sensing element, as taught by Crowley'229, since it would allow the sensing device to be easily introduced into a test subject as well as the precise locating of the sensing device within the test subject.

3. Claims 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcala et al.'405, further in view of Lakowicz et al.'534 further in view of Crowley'299, as applied to claim 1, further in view of Darrow et al.'651 (previously cited).

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Alcala et al.'405 further in view of Lakowicz et al.'534 further in view of Crowley'299 discloses all the elements of the current invention, as discussed in paragraph 2 above, except for the device comprising at least one reference group, wherein the reference group and reporter group are excited at the same wavelengths and wherein the luminescence of the reporter group and reference group are detected at the same wavelength.

Darrow et al.'651 teaches the use of a reference group having excitation and emission wavelengths similar to a fluorophore of interest while using a phase-modulation method in order to minimize instrumental errors (page 24, sections [0306] and [0310]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sensing element of Alcala et al.'405 further in view of Lakowicz et al.'534 further in view of Crowley'229 to include a reference fluorophore having excitation and emission wavelengths similar to the fluorophore of interest, as taught by Darrow et al.'651, since it would minimize instrumental errors. It is noted that the sensing element discussed in Example 5 of Lakowicz et al.'534 uses the phase-modulation method discussed in Darrow et al.'651.

Response to Arguments

4. Applicant's arguments, see lines 1-6 of page 8 of the Remarks, filed 04 September 2007, with respect to the rejection(s) of claim(s) 1, 3, 6, 7, 12, 19-32 and 34-36 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Alcala et al.'405, Lakowicz et al.'534, Darrow et al.'651 and Crowley'229.

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Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etsub D. Berhanu whose telephone number is 571.272.6563. The examiner can normally be reached on Monday - Friday (7:00 - 3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDB



ERIC F. WINAKUR
PRIMARY EXAMINER